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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/754,562	01/04/2001	Karl Heinz Kremer	10432-8	3723

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EXAMINER

WALLERSON, MARK E

ART UNIT	PAPER NUMBER
2626	

DATE MAILED: 03/17/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No. 09/754,562	Applicant(s) KREMER ET AL.	
	Examiner Mark E. Wallerson	Art Unit 2626	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 21 December 2005.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-19 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-19 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|---|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date <u>12/19/01</u> | 6) <input type="checkbox"/> Other: _____ |

Part III DETAILED ACTION

Notice to Applicant(s)

1. This action is responsive to the following communications: amendment filed on 12/21/05.

2. This application has been reconsidered. Claims 1-19 are pending.

Claim Rejections - 35 USC § 112

3. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

4. Claims 1-19 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention. There is no disclosure in the original specification for:

- Generating flags in response to first inputs received from the user interface.
- Storing specified characters for each of the selected pages in the memory in a non-image format.
- Storing those specified images in response to second inputs received from the user interface.
- Storing on a plurality-of-page basis, global tab stock data in the memory
- Storing the global tab stock in response to a third input received from the user interface.

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- Receiving the specified characters to be rendered on the tabs and the global tab stock data from the job preparation station and printing the specified characters on the tabs of the selected pages.
- Generating flags stored in a first memory region
- Storing specified characters in a second memory region in a non-image format.
- Storing global tab stock data identifying tab stock in a third memory region.

Applicant supplied alleged support for this subject matter at page 22, line 7 to page 23, line 14.

However, the Examiner does not believe that this area or any other adequately discloses the amended subject matter. If Applicant believes this rejection to be in error, Applicant is requested to provide SPECIFIC support for this subject matter.

Claim Rejections - 35 USC § 102

5. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

6. Claims 1, 2, 3, 5, 6, 7, 8, 10, 11, 12, 13, 15, 16, 17, and 18 are rejected under 35

U.S.C. 102(b) as being anticipated by Hube (U.S. 5,337,161).

With respect to claims 1, 6, 11, and 16, Hube discloses a printing system for printing a document (figure 1), the printing system comprising: a job preparation station (6 and 7), including processor (25) and a memory (56), said job preparation station generating a flag (pages

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specified to be programmed as tab stock) stored in memory indicating that a selected page in a document to be printed contains a tab (column 7, lines 5-12 and column 8, lines 15-27), and said job preparation station including an input device (64 or 52) for a user to input the marker (text) and information to be rendered on said tab (column 7, lines 5-12); and a print output module (8) that receives the flag and information to be rendered on said tab and prints said information on said tab (column 8, lines 1-46).

With regard to claims 2, 7, 12, and 17, Hube discloses that the tab flag and tab information are stored as objects (column 7, lines 5-16 and column 8, lines 15-27).

With respect to claims 3, 8, 13, and 18, Hube discloses the objects are page objects (column 8, lines 15-27).

With regard to claims 5, 10, and 15, Hube discloses the tab sheet is created as an additional page to the document (column 7, lines 9-12).

Claim Rejections - 35 USC § 103

7. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

8. Claims 4, 9, 14, and 19 are rejected under 35 U.S.C. 103(a) as being unpatentable over Hube in view of Neuhard et al (Neuhard) (U.S. 6,052,198).

With respect to claims 4, 9, 14, and 19, Hube differs from claims 4, 9, 14, and 19 in that he does not clearly disclose that the objects comprise PDF objects.

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Neuhard discloses means for organizing files associated with a job ticket wherein the file item includes a PDF file (column 6, lines 8-16). Therefore, it would have been obvious to one of obvious skill in the art at the time of the invention to have modified Hube wherein the file objects comprise PDF objects. It would have been obvious to one of obvious skill in the art at the time of the invention to have modified Hube by the teaching of Neuhard in order to obtain a variety of data files.

Conclusion

9. THIS ACTION IS MADE FINAL. Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

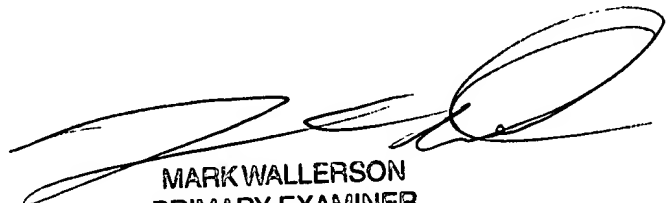
Any inquiry concerning this communication or earlier communications from the examiner should be directed to Mark E. Wallerson whose telephone number is (571) 272-7470. The examiner can normally be reached on Monday-Friday - 6:30-4:00.

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If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Kimberly Williams can be reached on (571) 272-7471. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Mark E. Wallerson
Primary Examiner
Art Unit 2626



MARK WALLERSON
PRIMARY EXAMINER